IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27-10-2006

CORAM

THE HONOURABLE MR. JUSTICE D. MURUGESAN
AND
THE HONOURABLE MR. JUSTICE V. RAMASUBRAMANIAN

WRIT APPEAL No.863 of 2006
and
W.P.No.25372 of 2006 and W.P.No.28352 of 2004
and
C.R.P.Nos.800, 808, 809 and 810 of 2006

W.A.No.863 of 2004:

B.Mohamed Yousuff
Proprietor, M/s.Mujeeb Modern Rice Mill,
Pathirapuliyur Road,
Palappattu Village 604 302,
Chendur Post, Tindivanam Taluk,
Villupuram District, Tamil Nadu. ..Appellant in WA.863/2004,
Petitioner in WP.25372/2006
R.4 in WP.28352/2004
R.1 in CRP[NPD].800, 808 to 810/2006.

Vs.

1.M/s.Prabha Singh Jaswant Singh,
No.1, Khari Baoli,
Delhi 110 006 rep., by its
Power of Attorney Mr.C.Raghu.

2.The Registar of Trade Marks,
O/o.the Trade Marks Registry,
Mumbai Boudhik Sampanda Bhavan,
Near Antop Hill Post Office,
S M Road, Antop Hill,
Mumbai-400 037.

3.The Assistant Registrar of Trade
Marks, O/o.The Trade Marks Registry,
Chennai IPR Building, G.S.T.Road,
Guindy, Chennai-600 032.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

4.The Controller General of Patents,
Designs and Trade Marks,
Government of India,
Boudhik Sampanda Bhavan,
Near Antop Hill Post Office,
S.M.Road, Antop Hill,
Mumbai-400 037.

5. B.Mohamed Sheriff

6. B.Hyder Ali
(The respondents 5 and 6 are given up in this writ appeal)

7. Shanmugha Rice Mill,
S.F.No.156, Kovai Road,
Kadaiyur Post,
Via Kangayam Taluk,
Periyar District,
Tamil Nadu .. Respondents 1 to 7 in WA.863/2006
Petitioner and Respondents 2 to 4 nil and Respondents 5 to 7 in WP.28352/2004
R.1 Nil and Respondents 4, 5 in WP.25372/2006.

1. M/S.Prabha Singh Jaswanth Singh
rep. by Joginder Singh Malhotra
No.1, Khari Baoli, Delhi - 110006.

2. Joginder Singh Malhotra
No.1, Khari Baoli, Delhi - 110006.

6. M/S.P.Doraisami Gounder
Shanmugha Rice Mill.
S.F.No.156, Kovai Road,
Kadaiyur (P.O) Kangeyam Taluk,
Erode District

7. P.Ponnusamy Gounder
S.F.No.156, Kovai Road,
Kadaiyur (P.O) Kangeyam Taluk,
Erode District.

8. P.Papathall
W/O.P.Ponnusamy Gounder
S.F.No.156, Kovai Road,
Kadaiyur (P.O) Kangeyam Taluk,
Erode District.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

9. D.Deivathall
W/O.Late P.Doraisamy Gounder
S.F.No.156, Kovai Road,
Kadaiyur (P.O) Kangeyam Taluk,
Erode District.

10. D.Eswaramurthy
S/O.Late P.Doraisamy Gounder,
S.F.No.156, Kovai Road,
Kadaiyur (P.O) Kangeyam Taluk,
Erode District.

11. D.Rekkiyappasamy
S/O.Late. P.Doraisamy Gounder
S.F.No.156, Kovai Road,
Kadaiyur (P.O) Kangeyam Taluk,
Erode District. Respondents 1,2,6 to 12 in WP.25372/2006. RR.9.10,5 to 8 and petitions 2 and 3 in CRP.800/2006 RR.1,2 & 6 nil and RR2 to 4 in CRP.800/2006 to 810/2006 and petitioners 1 and 2 in CRP.808/2006 to 810/2006.

12. The Registrar
Intellectual Property Appellate Board
Guna Complex Annex-1, 2nd Floor,
443, Anna Salai, Teynampet,
Chennai - 18. R.12 in WP.25372/2006

R1. The Registrar of Trade Mark
Office of the Trade Mark Registry
Mumbai, Central Building
M.Karve Road, Mumbai - 400020.

2. The Assistant Registrar of Trade Mark,
Office of the Trade Mark Registry
Chennai Rajaji Bhavan,
'D' Wing, Besant Nagar,
Chennai - 90.

3. The Controller General of Patents
Designs and Trade Marks
Government of India,
Central Building,
M.Karve Road, Mumbai - 400020. RR1 to R3 in WP.28353/2004 RR3,4 and 2 in CRP.800/2006.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

For Appellants/Petitioners
in Writ Appeal, Writ
Petitions and Civil Revision
Petitions : Mr.P.S.Raman, Senior Advocate
for
M/s.Saravana Sowmiyan

For respondents
in Writ Appeal, Writ
Petitions and Civil Revision
Petitions : Mr.S.J.Jagadev and
Gladys Daniel.

Writ Appeal filed under clause 15 of the Letters Patent against the Order of this Court dated 30.06.2006 and made in WPMP.No.34413/2004 in WVMP No.1937/2004 in WP.No.28352/2004.

WPMP.No.34413/2004: Petition presented to this Court to grant order of Interim Injunction against respondents 1 and 2 restraining them from entering the name of Respondent 4 or renew / restore the mark in pursuance of the application for renewal filed in TM 12 and 13 filed on 16.9.2004 before the 2nd Respondent.

WVMP.No.1937/2004: Petition to vacate the interim Order granted on 1.10.2004 made in WPMP.34413/2004 in WP.28352/2004.

WP.No.25372/2006: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Certiorarified Mandamus, calling for the records of the 12th respondent by proceedings dated 15.3.2006 in order No.35 of 2006 made in Original Rectification Application NO.1/2005/TM/[CH] and quash the same in so far as against the petitioner and consequently directing the 4th Respondent to remove the Trade Mark "Maharaja Special" in Trade Mark No.325536 from the Register of Trade Marks.

WP.28352/2004: Writ of Mandamus directing the respondents 1 to 3 not to record the names of Respondents 4 to 6 in the name of Respondents 4-6 or 7 or renew or restore the Mark "MAHARAJA" for Rice which has been registered in the name as evidenced by the records.

Civil Revision Petition filed under Article 227 of constitution of India, against the Order dated 15.03.2006 made in ORA.No.1 of 2005 on the file of Honourable Intellectual Property Appellate Board, Chennai [CRP.800/2006].

WEB COPY
https://hcservices.ecourts.gov.in/hcservices/

2) against the order dated 15.3.2006 made in Review Petitions R.P.No.2 of 2004 to 4 of 2004 in OA.No.24 of 2004 to 26 of 2004 respectively on the file of the Honourable Intellectual Property Appellate Board, Chennai [CRP.Nos.808 to 810/2006]

COMMON JUDGMENT

V. RAMASUBRAMANIAN, J.

The writ appeal, 2 writ petitions and 4 civil revision petitions arise out of a cobweb of litigation, in which, the word "Maharaja" and his caricature are caught in a triangular contest.

2. The parties involved in this contest, carry on business in the sale of rice and grains, under the brand name "MAHARAJA" with or without a caricature/device of a Maharaja. Since they are arrayed in different positions in the writ appeal, writ petitions and civil revision petitions, their description as petitioners or respondents would defy uniformity and would only create confusion. Therefore, they are referred to herein, as the 'Delhi Party', 'Tindivanam Party' and 'Kangayam Party', for the sake of convenience, since they have their head offices at Delhi, Tindivanam (Villupuram District, Tamilnadu) and Kangayam (Erode District, Tamilnadu) respectively.

3. Since the parties hereto have wielded against one another, almost all the weapons available under the Trade Marks Act, 1999, such as (i) opposition for registration, (ii) Assignment (iii) appeals and review petitions before the Appellate Board, (iv) rectification petition, (v) petition for prosecution (vi) civil suit and (vii) proceedings under Article 226/227 of the Constitution, it is necessary to give a brief prelude, before plunging into complete factual details, though it would be at the cost of repetition.

4. The Delhi party had a registration in respect of the word mark, "MAHARAJA SPECIAL" from 23-5-1977 without any picture or caricature, in Class 30, in respect of grains and rice, claiming user since 1966. The Tindivanam and Kangayam parties applied for registration of the same word mark along with the caricature of a Maharaja, on 4-8-1992 and 15-9-1992 respectively in respect of the same goods, claiming user since 1983 and 1980 respectively. It is pertinent to note that the application of the Tindivanam Party for registration, was made in the names of B.MOHAMMED YOUSUF, B.MOHAMMED SHERIFF AND B.HYDER ALI, trading as MUJEEB MODERN RICE MILL.

WEB COPY
https://hcservices.ecourts.gov.in/hcservices/

5. When the applications of Tindivanam and Kangayam parties for registration, were published in the Trade Marks Journal in the year 2000, the Tindivanam and Kangayam parties filed notices of opposition against each other. The notices of opposition filed by them against each other, were dismissed and the applications for registration filed by both of them were allowed by the Assistant Registrar of Trade Marks, by orders dated 23-1-2004 and 30-1-2004. But while doing so, the Assistant Registrar imposed different conditions upon them for registration. In respect of the Tindivanam party, the Assistant Registrar directed them to use the mark always with the full name and address of their firm in prominent feature on the label, sticker etc., under section 12 of the Act without any territorial restriction. But in respect of the Kangayam party, the Assistant Registrar not only imposed the same condition, namely that they shall use the mark along with the name and address of their firm prominently, but also imposed a territorial restriction to the user of the mark, within the State of Tamilnadu only.

6. Aggrieved by the conditional registration (granted by the Assistant Registrar under order dated 30-1-2004) restricting their area of operation to the State of Tamilnadu only, the Kangayam party filed an appeal in O.A.No.25 of 2004 before the Intellectual Property Appellate Board, hereinafter referred to as the 'Board'. Contending that no registration ought to have been granted in favour of Kangayam party even conditionally, B.Mohammed Yousuf, describing himself as the Proprietor of Mujeeb Modern Rice Mill (who is also hereinafter referred to only as the Tindivanam party, though the actual Tindivanam party who filed the application for registration comprised of 3 persons) filed an appeal in O.A.Nos.24 of 2004 before the Board. Similarly, challenging the grant of registration to the Tindivanam party, (granted by the Assistant Registrar under order dated 23-1-2004) the Kangayam party filed an Appeal in O.A.No.26 of 2004.

7. By a detailed order dated 6-8-2004, the Intellectual Property Appellate Board dismissed O.A.No.26 of 2004 filed by the Kangayam party against the grant of registration to Tindivanam party. Even while doing so, the Board directed the Registrar to amend the application for registration filed by the Tindivanam party by restricting the same to the first named brother namely B.Mohammed Yousuf, among the 3 original applicants. It is pertinent to point out here that by the time the said order was passed (on 6-8-2004) the Registrar had already issued a certificate of registration dated 26-2-2004 in favour of the original 3 applicants constituting the Tindivanam Party. Therefore the question of amending the application for registration did not arise on that date and any amendment could have been done only for the certificate of registration. But nevertheless, the Appellate Board did not take note of

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

the issue of the certificate of registration in favour of the 3 original applicants constituting the Tindivanam party and issued the aforesaid direction for amendment of the application of the Tindivanam Party to enable one person to get the certificate as a proprietor.

8. By another order of the same date namely 6-8-2004, the Board allowed the appeal of the Tindivanam party O.A.No.24 of 2004 and dismissed the other appeal of the Kangayam party O.A.No.25 of 2004. As a result of the orders passed by the Appellate Board in all the 3 appeals, (O.A.Nos.24, 25 and 26 of 2004), the Kangayam party became completely disentitled to use the trade mark and the Tindivanam party's right to use the mark got upheld.

9. At that time, the Kangayam party came to know about the registration of a similar mark by the Delhi party as early as in 1977 and hence entered into a Deed of Assignment with the Delhi party on 5-10-2004. Simultaneously, the Kangayam party filed Review Petitions in R.P.No.2, 3 and 4 of 2004, against the orders passed in the appeals O.A.Nos.24, 25 and 26 of 2004, but the same were dismissed by the Intellectual Property Appellate Board, by a common order dated 15-3-2006, holding that the assignment made by the Delhi party in favour of the Kangayam party, being a subsequent event, cannot be a ground for review of its earlier orders. But as a matter of fact, the review petitions were not filed on the strength of the Assignment entered into on 5-10-2004, but were filed on other grounds including that the direction issued by the Board for amending the application for registration, was an error in view of the fact that there is a prescribed procedure for amending a certificate of registration. As against the said order passed in the Review Petitions, the Kangayam party has filed Civil Revision Petitions in C.R.P.Nos.808, 809 and 810 of 2006 under Article 227 of the Constitution.

10. In the meantime, the Delhi party, on coming to know about the rival claims of the Tindivanam and Kangayam parties regarding the same trade mark, filed a civil suit in C.S.No.726 of 2004, followed by a Writ petition in W.P.No. 28352 of 2004 for preventing renewal of registration. But, as stated above, the Kangayam party entered into a Deed of Assignment with the Delhi party and compromised the dispute with them. Pending the said writ petition, the Delhi party obtained an interim order restraining the Registrar from renewing the registration of the Tindivanam party, in W.P.M.P.No.34413 of 2004. Against the said interim order, the Tindivanam party has filed the writ appeal W.A.No.863 of 2006.

11. While the above proceedings were in progress, the Tindivanam party filed 2 petitions namely (1) for Rectification of the Register in O.R.A.No. 1 of 2005 on the file of the Intellectual Property Appellate

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

Board for the removal of the Delhi Party's trade mark and (2) for prosecution of the Delhi party under section 107 of the Act before the Registrar.

12. The rectification application filed by the Tindivanam party was partly allowed by the Board, by its order dated 15-3-2006 directing the Registrar to rectify the Register, restricting the area of operation of the Delhi party only to Delhi. Aggrieved by such a partial rectification ordered against them by the Board, the Delhi party has filed a civil revision petition in C.R.P.No.800 of 2006. The Tindivanam party also challenged the order passed in their rectification application, by way of a writ petition in W.P.25372 of 2006, contending that the Delhi party was not entitled to have the use of the trade mark even within Delhi.

13. The prosecution application filed by the Tindivanam party against the Delhi party was allowed by the Registrar as against which, the Delhi party filed an appeal to the Board in O.A.No.13 of 2005. The Board dismissed the said appeal by an order dated 15-3-2006, forcing the Delhi party to file C.R.P.No.801 of 2006. The said civil revision petition is delinked from the batch since all other cases revolve around the same issues but C.R.P.No.801 of 2006 stands independently of the common issues.

14. Thus in brief, there are 5 civil revision petitions, 2 writ petitions and a writ appeal. While 3 civil revision petitions are filed by the Kangayam party arising out of applications for registration and the rival notices of opposition between Tindivanam and Kangayam parties, two revision petitions are by Delhi party against the rectification order suffered by them and the prosecution sanctioned against them. Out of the 2 writ petitions, one is by Delhi party for preventing renewal of the Tindivanam party's registration and the other is by Tindivanam party challenging the order of the Intellectual Property Appellate Board passed in their rectification application, merely restricting the area of operation of the Delhi party's registration but not removing their mark from the register. The writ appeal filed by the Tindivanam party is against the interim order granted in favour of the Delhi party restraining the renewal of registration in favour of Tindivanam party. All these petitions (except C.R.P.No.801 of 2006) were taken up for disposal together, in view of the fact that the dispute is intertwined between them and a finding in one cannot be rendered without any bearing on the other.

15. We have heard Mr.S.J.Jagadev, learned Counsel appearing for the Delhi party, Ms.Gladys Daniel, learned counsel appearing for the Kangayam party and Mr.P.S.Raman, learned Additional Advocate General appearing for the Tindivanam party.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

16. Before proceeding to decide the inter se dispute between the parties, a preliminary was issue raised by the parties at the outset, about the nature of the remedy available to a person aggrieved by an order of the Intellectual Property Appellate Board, which requires consideration. While the Kangayam party and the Delhi party have chosen to invoke the supervisory/revisional jurisdiction of this court under Article 227 of the Constitution, the Tindivanam party has chosen to invoke the extraordinary jurisdiction (writ) of this court under Article 226 of the Constitution, against the orders of the Intellectual Property Appellate Board. The counsel for the parties advanced detailed arguments on this issue and hence it has become necessary to resolve the same for future application.

17. PRELIMINARY ISSUE:- A plain reading of Articles 226 and 227 of the Constitution shows—

(a) that the jurisdiction of the High Court under Article 226 is original, while the jurisdiction under Article 227 is supervisory and revisional;

(b) that the power of the High Court under Article 226 is to issue directions, orders or writs for the enforcement of any of the rights conferred by Part III of the Constitution and for any other purpose, while the power of the High Court under Article 227 is a power of superintendence, both administrative as well as judicial, over courts and Tribunals;

(c) that the power conferred under Article 226 is not restricted by the location of the seat of the Government or the authority or person against whom it is exercised, if the cause of action for its exercise arose in whole or in part within its territorial limits, while the power conferred under Article 227 is restricted to the courts and Tribunals located within the territories in relation to which the High Court exercises jurisdiction; and

(d) that the jurisdiction under Article 226 extends over any person, authority or the Government, while the jurisdiction under Article 227 is confined to courts and Tribunals including those exercising quasi judicial functions.

18. The power under Article 227, being a revisional power, varies in its scope and ambit, than the power under Article 226, which is original. Moreover, the remedy of a Letters Patent Appeal to the Division Bench of the High Court, (wherever applicable) is available to a person

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

aggrieved by an order passed by a single Judge, in a writ petition under Article 226 of the Constitution, but no such appellate remedy is available against an order passed under Article 227 of the Constitution.

19. In Umaji Keshao Meshram –vs- Radhikabai 1986 Supp.SCC 401, the Supreme Court analysed the distinction between these 2 Articles threadbare, in paragraphs 100, 101 and 107, on the following lines.

> "100. … … … … … … .
>
> Under Article 226 the High Courts have power to issue directions, orders and writs to any person or authority including any government. Under Article 227 every High Court has power of superintendence over all courts and tribunals throughout the territory in relation to which it exercises jurisdiction. The power to issue writs is not the same as the power of superintendence. By no stretch of imagination can a writ in the nature of habeas corpus or mandamus or quo warranto or prohibition or certiorari be equated with the power of superintendence. These are writs which are directed against persons, authorities and the State. The power of superintendence conferred upon every High Court by Article 227 is a supervisory jurisdiction intended to ensure that subordinate courts and tribunals act within the limits of their authority and according to law (see State of Gujarat vs. Vakhatsinghji Vajesinghji Vaghela (AIR 1968 SC 1481) and Ahmedabad Mfg. & Calico Ptg. Co. Ltd. vs. Ram Tahel Ramnad ((1973) 1 SCR 185)). The orders, directions and writs under Article 226 are not intended or this purpose and the power of superintendence conferred upon the High Courts by Article 227 is in addition to that conferred upon the High Courts by Article 226. Though at the first blush it may seem that a writ of certiorari or a writ of prohibition partakes of the nature of superintendence inasmuch as at times the end result is the same, the nature of the power to issue these writs is different from the supervisory or superintending power under Article 227. The powers conferred by Articles 226 and 227 are separate and distinct and operate in different fields. The fact that the same result can at times be achieved by two different processes does not mean that these two processes are the same.
>
> 101. Under Article 226 an order, direction or writ is to issue to a person, authority or the State. In a proceeding under that article the person, authority

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

or State against whom the direction, order or writ is sought is a necessary party. Under Article 227, however, what comes up before the High Court is the order or judgment of a subordinate court or tribunal for the purpose of ascertaining whether in giving such judgment or order that subordinate court or tribunal has acted within its authority and according to law.

107. Petitions are at times filed both under Articles 226 and 227 of the Constitution … … … . In our opinion, where the facts justify a party in filing an application either under Article 226 or 227 of the Constitution, and the party chooses to file his application under both these articles, in fairness and justice to such party and in order not to deprive him of the valuable right of appeal the court ought to treat the application as being made under Article 226, and f in deciding the matter, in the final order the court gives ancillary directions which may pertain to Article 227, this ought not to be held to deprive a party of the right of appeal under Clause 15 of the Letters Patent where the substantial part of the order sought to be appealed against is under Article 226"

20. The differences in jurisdiction between Articles 226 and 227 are brought out by the Supreme Court in Surya Dev Rai –vs- Ram Chander Rai (2003) 6 SCC 675, in the following words:-

"25. Upon a review of decided cases and a survey of the occasions, wherein the High Courts have exercised jurisdiction to command a writ of certiorari or to exercise supervisory jurisdiction under Article 227 in the given facts and circumstances in a variety of cases, it seems that the distinction between the two jurisdictions stands almost obliterated in practice. Probably, this is the reason why it has become customary with the lawyers labeling their petitions as one common under Articles 226 and 227 of the Constitution, though such practice has been deprecated in some judicial pronouncement. Without entering into niceties and technicality of the subject, we venture to state the broad general difference between the two jurisdictions. Firstly, the writ of certiorari is an exercise of its original jurisdiction by the High Court; exercise of supervisory jurisdiction is not an original jurisdiction and in this sense it is akin to appellate, revisional or corrective jurisdiction.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

> Secondly, in a writ of certiorari, the record of the proceedings having been certified and sent up by the inferior court or tribunal to the High Court, the High Court if inclined to exercise its jurisdiction, may simply annul or quash the proceedings and then do no more. In exercise of supervisory jurisdiction, the High Court may not only quash or set aside the impugned proceedings, judgment or order but it may also make such directions as the facts and circumstances of the case may warrant, maybe, by way of guiding the inferior court or tribunal as to the manner in which it would now proceed further or afresh as commended to or guided by the High Court. In appropriate cases the High Court, while exercising supervisory jurisdiction, may substitute such a decision of its own in place of the impugned decision, as the inferior court or tribunal should have made. Lastly, the jurisdiction under Article 226 of the Constitution is capable of being exercised on a prayer made by or on behalf of the party aggrieved; the supervisory jurisdiction is capable of being exercised suo motu as well."

21. In L.Chandrakumar's case (1997) 3 SCC 261, the Constitution Bench of the Supreme Court held in para 91 that "all decisions of Tribunals, whether created pursuant to Article 323-A or Article 323-B of the Constitution will be subject to the High Court's writ jurisdiction under Articles 226/227 of the Constitution before a Division Bench of the High court within whose territorial jurisdiction the particular Tribunal falls." In para 99 of the same judgment, the Constitution Bench declared clause 2 (d) of Article 323-A and clause 3 (d) of Article 323-B unconstitutional to the extent they excluded the jurisdiction of the High Courts under Article 226/227 and that of the Supreme Court under Article 32 of the Constitution. Section 28 of the Administrative Tribunals Act and the 'exclusion of jurisdiction' clauses contained in all other legislations enacted under the aegis of Article 323-A and 323-B of the Constitution were also declared unconstitutional by the said judgment. However, the Supreme Court held that these Tribunals created under Articles 323-A and 323-B can play a 'supplemental role' though they are not 'substitutes' for the High Court and consequently, they are possessed of powers to test the constitutional validity of statutory provisions and rules. In such a view of the matter, the Supreme Court thought fit to hold that 'all decisions of these Tribunals will be subject to scrutiny before a Division Bench of the High Court within whose jurisdiction the Tribunal falls".

22. Throughout the said judgment, the Supreme Court referred to the power of scrutiny of the High Court, as one under 'Article 226/227 of

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

the Constitution' and no distinction was drawn between the powers conferred under these Articles. The distinction was perhaps not necessary, on account of 2 factors, namely (1) the view taken by the Supreme court that the Tribunals constituted under Articles 323-A and 323-B are 'courts of first instance' thereby indicating that the High court was actually exercising a supervisory jurisdiction and (2) the direction issued by the Supreme Court that all decisions of the Tribunals would be subject to scrutiny by the Division Bench of the High Court, leaving no scope for invoking the Letters Patent for an intra court appeal. Thus the distinction between the power under Article 226 and the power under Article 227 became insignificant, at least for an ordinary litigant, if not for a legal pundit, in so far as the orders passed by the Tribunals constituted under Article 323-A and 323-B of the Constitution were concerned, since the petitions arising out of those orders are to be heard only by a Division Bench. Therefore, a petition challenging an order of a Tribunal constituted under Article 323-A or 323-B of the Constitution, is always posted before a Division Bench and the nomenclature given to the same, makes no difference.

23. But that is no solace since there are other 'courts and Tribunals', which are constituted under various Enactments, apart from those constituted under Article 323-A and 323-B of the Constitution. They are creatures of Statutes and they are not to be equated to the Tribunals created under Article 323-A or 323-B of the Constitution. As against the orders passed by some of those Tribunals, writ petitions under Article 226 of the Constitution have always been entertained.

24. Coming to the orders of the Intellectual Property Appellate Board, it is seen that the same is not a tribunal constituted under Article 323-A or 323-B of the Constitution. It is created by an Act of Parliament, namely the Trade Marks Act, 1999. Some of the powers exercised by the Registrar and the powers exercised by the High court in its original side, have now been conferred upon the said Board, by the new Trade Marks Act, 1999.

25. Under the Trade and Merchandise Marks Act, 1958, (old Act) the power of rectification, cancellation and variation of registration was vested concurrently with the Registrar and the High Court under Section 56 of the Act. All other ancillary powers were conferred exclusively upon the Registrar. Where a suit for infringement of a registered trade mark was pending before a Court and the validity of the registration of the plaintiff's mark or the defendant's mark itself was questioned in the said suit, the application for rectification was made entertainable, only by the High Court under Section 107 of the Act. Any order or decision of the Registrar was made appealable to the High Court under Section 109(2) and such appeal was to be heard by a single Judge of the High Court, under

https://hcservices.ecourts.gov.in/hcservices/

Section 109(4) of the Act.

26. An application for rectification directly filed before the High Court was also to be heard by a single Judge, under Section 108(2) of the old Act and every order passed by a single Judge, either on an application for rectification under Section 108(2) or an appeal under Section 109(2), was made appealable to a Bench of the High Court under Sections 108(3) and 109(5) of the Act. Thus, under Act 43 of 1958, the High Court had ordinary original civil jurisdiction as well as civil appellate jurisdiction specifically provided for under the Act itself. The application for rectification before this Court, was an original proceeding, and an appeal against any order of the Registrar and an appeal against every order of the single Judge were appellate proceedings. The appeal against the order of the single Judge on an application for rectification (to the Division Bench) and an appeal against the order of the Registrar(to the single Judge) were like first appeals. The appeal against the order of the single Judge arising out of an appeal against the order of the Registrar, was like a second appeal, though it was not under Section 100 of the Code of Civil Procedure.

27. The new Act, Act No.47 of 1999, provided for the constitution of a Board known as 'Intellectual Property Appellate Board' virtually to exercise the jurisdiction vested in the High Court under the old Act and such Board was to exercise original jurisdiction in respect of certain matters (such as rectification application) and appellate jurisdiction in respect of certain other matters (over the orders of the Registrar). But no appeal was provided against the order passed by the Tribunal under the new Act and Section 93 imposed a bar on the jurisdiction of Courts in relation to matters over which the Appellate Board was conferred with jurisdiction. However, on the principle that the bar under Section 93 of Act 47 of 1999 cannot exclude the jurisdiction of this Court, under Article 226/227 of the Constitution, the orders of the Appellate Board become subject to the jurisdiction of this Court.

28. In the backdrop of the above legal position under the new Act, the power of this Court in scrutinizing the orders of the Appellate Board is the power to issue a Writ of Certiorari and/or Mandamus as well as a power of judicial superintendence. Therefore, in our considered view, a petition for the issue of a Writ of Certiorari or Mandamus would lie against an order of the Appellate Board since the Appellate Board exercises both original as well as appellate jurisdiction. But while doing so, the writ petitions could be heard only by a Division Bench of this Court in view of the fact that what is vested with the Appellate Board is akin to the power vested upon a single Judge of the High Court under Sections 108(2) and 109(4) of Act 43 of 1958 (old Act) and hence the writ petitions arising out of the orders of the Appellate Board could be

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

treated as akin to the proceedings before a Division Bench under Sections 108(3) and 109(5) of the old Act.

29. Therefore we hold on the preliminary issue that a Writ of Certiorari and/or Mandamus would lie against any order or decision of the Intellectual Property Appellate Board under Article 226 of the Constitution, to the Division Bench of the High Court. Consequently, we direct all the civil revision petitions before us in this batch of cases, to be re numbered as writ petitions.

30. CHALLENGE AS TO THE JURISDICTION OF THE APPELLATE BOARD:

One of the main grounds of attack by the Delhi party against the orders of the Appellate Board is that their trade mark was registered in the Office of the Trade Mark Registry at Delhi and that therefore the Appellate Board committed a serious error of territorial jurisdiction in entertaining the application for rectification filed by the Tindivanam party at Chennai. To substantiate the said contention, Mr.S.J.Jagadev, learned counsel appearing for the Delhi party invited our attention to Sections 83 and 84 of the Trade Marks Act, 1999 and Rules 4, 6 and 7 of the Trade Marks Rules, 2002. While Section 83 of the Act empowers the Central Government to establish an Appellate Board, Section 84 deals with the composition of the Board. It is pertinent to see that Sections 83 and 84 deal with establishment as well as composition of a single Appellate Board, which could have more than one Bench. Every Bench shall consist of a judicial member and a technical member and shall sit at such place as the Central Government may by notification specify. Under Section 84(4), the Central Government may, by notification, make provisions as to the distribution of business of the Appellate Board amongst the Benches.

31. Rule 4 of the Trade Marks Rules, 2002, gives an indication of what is an 'appropriate office of the Trade Mark Registry'. In relation to a trade mark already registered, Rule 4 defines the appropriate office to be the office of the Registry within whose territorial limits the principal place of business in India of the registered proprietor of the Trade Mark is situate. In relation to a trade mark for which an application for registration is pending on the date of the notification of the said rules or is made after the date of the notification, the appropriate office shall be the office of the Registry within whose territorial limits, the principal place business of the applicant as disclosed in the application is located. The jurisdiction of the appropriate office, once determined on the basis of the original principal place of business, shall not get affected by any change in the principal place of business, in view of rule 4. Rule 6 provides for an entry to be made by the Registrar in respect of every mark, of the appropriate office of the Trade Mark Registry, in relation to the said mark. Rule 7 provides

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

for transfer of pending applications and proceedings to appropriate offices of the Trade Mark Registry. Therefore, on a conjoint reading of the above provisions of the Act and the Rules, the learned counsel for the Delhi party contended that in as much as the Principal place of business of the Delhi party was at Delhi and the appropriate office of the Registry in relation to their mark, as entered in the Register, is Delhi, the application for rectification filed by the Tindivanam party before the Appellate Board at Chennai, ought to have been dismissed for want of territorial jurisdiction.

32. But we are unable to countenance the said contention of the learned counsel for the following reasons:-

(a) Section 83 contemplates establishment only one Board for the entire country, though there could be several Benches of the same Board at different places under Section 84.

(b) Section 84(2) empowers the Central Government to issue notifications prescribing the places at which a Bench shall sit and Section 84(4) enables the Central Government to make provisions as to the distribution of business amongst the various Benches. However, under Section 84(5), the Chairman of the Appellate Board is vested with the absolute discretion to decide whether any matter falls within the purview of the business allocated to a Bench. In the present case, all the orders passed by the Appellate Board which are impugned in these proceedings, were rendered by a Bench consisting of the Chairman of the Appellate Board and a member. Therefore, irrespective of where the applications had been presented and taken on file, the Chairman and the member who passed the orders impugned in these proceedings, had the jurisdiction and powers to decide the same. In other words, if the Tindivanam party had filed an application for rectification at Delhi, it would have been heard by the same Appellate Board at Delhi and the same could not have made any difference.

(c) The rules relied upon by the learned counsel deal only with the question of appropriate office of the Registry and they do not deal with the question of jurisdiction of the Appellate Board or its Benches. The Appellate Board, in exercise of the powers conferred by Section 92 of the Act, has also issued the rules known as 'Intellectual Property Appellate Board (Procedure) Rules, 2003, Rule 16 of which, reads as follows:-

"16. Date of hearing to be notified.—

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

> The Appellate Board shall notify the parties the date and place of hearing of the application or appeal in such manner as the Chairman may by general or special order direct."

Thus, the issue of jurisdiction raised by the learned counsel for the Delhi party gets obliterated by the fact that the objection is not with respect to the power of the Board which heard and decided the matters, but only with respect to the place in which the same Board heard and decided the matter. Under such circumstances, we hold that the orders of the Appellate Board challenged in these impugned proceedings cannot be said to suffer from want of territorial jurisdiction.

33. MERITS OF THE CASE:-

Now coming to the merits of the case, it is seen that despite the hullabaloo created by the parties, weaving one litigation out of the other and multiplying the dimensions of the contest which is already multi cornered as between themselves, the core of the dispute is simple and it can be summarized as follows:-

> i) The Delhi Party has obtained the word mark "MAHARAJA SPECIAL" registered as their Trademark bearing No.325536 on 23.5.1977 in Part-A of the Register in Class 30, in respect of grains and rice, claiming user since 1966 for the whole of India. They do not want their registration to be affected in any manner and they are aggrieved by the Appellate Board restricting their user to the territory of Delhi only.
>
> ii) The Kangayam Party has the lost the battle for the use of the mark both in their claim as the proprietor of the mark and in their claim as the "Assignee" from Delhi Party. Therefore if their claim to the use of the mark is accepted in any one of the capacities, they would be entitled to use the mark.
>
> iii) The Tindivanam Party not only wants registration of their mark but also wants the other 2 parties to be dislodged of their claim to the mark.
>
> Therefore if we test the rights of the parties to the trade mark in question, the answer to the core of the dispute could be found out and all the proceedings would automatically fall in tune with the said answer.

34. RIGHTS OF THE KANGAYAM PARTY:-

(A) On 15.9.1992, an application was made by the Kangayam party

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

for the registration of the word "MAHARAJA" and his caricature, under application No.581054, in Class 30 in respect of rice, claiming user since 12.9.1979.

(B) The Tindivanam Party filed a notice of opposition bearing No.MAS-57677 in respect of the application of the Kangayam Party bearing No.581054. By an order dated 30.1.2004, the notice of opposition filed by the Tindivanam Party was dismissed and the application of the Kangayam Party for registration was allowed subject to the condition that their trademark shall always be used along with the name and address of the firm prominently for sale of their rice in the State of Tamil Nadu only. Thus the Registrar granted registration of the mark to Kangayam Party, but it was restricted to the territory of Tamilnadu only.

(C) As against the said order, the Tindivanam Party filed an appeal in O.A.No.24 of 2004 before the Appellate Board, contending that the Kangayam Party should not be allowed to use the mark even in the State of Tamilnadu. The Kangayam party filed O.A.No.25 of 2004 on the file of the Appellate Board, contending that the territorial restriction imposed on them was illegal. The Kangayam Party also filed another appeal in O.A.No.26 of 2004 against the order of the Assistant Registrar dismissing their notice of opposition to the application for registration of the Tindivanam Party.

(D) By an order dated 6-8-2004, the Board dismissed O.A.No.26 of 2004 holding that the Kangayam Party had no right at all and further directing the Registrar to amend the application of the Tindivanam Party to confine it B.Mohammed Yousuf alone. By a separate order of the same date, the Board also allowed the Appeal O.A.No.24 of 2004 and dismissed the Appeal O.A.No.25 of 2004 holding that the Kangayam party cannot have registration at all and that they are not even entitled to have a registration confined to the State of Tamilnadu.

(E) In the meantime the Delhi Party came into the picture by filing a suit and obtaining an interim injunction against both the parties. Therefore, the Kangayam party chose to enter into a Deed of Assignment dated 5-10-2004 with the Delhi party and also filed TM-23 along with the Assignment Deed with the Registrar. After obtaining the assignment on 5-10-2004, the Kangayam party filed review applications in R.P.Nos. 2 to 4 of 2004 (on 13-10-2004) against the orders passed in Original Appeal Nos.24 to 26 of 2004.

(F) Thus the Kangayam Party who started staking a claim in their own right, reconciled themselves to a claim as an assignee under the Delhi Party.

(G) But to the misfortune of the Kangayam Party, the Delhi Party's assignment of the trade mark to the Kangayam Party was also held as illegal by the Appellate Board in an application for rectification filed by the Tindivanam Party in O.R.A.No.1 of 2005. Thus the Appellate Board foreclosed both the options for the Kangayam Party by holding that they have not established concurrent user of the mark and that the

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

assignment in their favour was also illegal.

(H) Therefore it is to be decided if the Kangayam Party has a right for the registration of the Trade Mark in their own right or at least entitled to claim a right to use the mark as an assignee of the Delhi Party.

(I) In so far as the claim of Kangayam Party for registration of the trade mark in their own right is concerned, the Assistant Registrar of Trade Marks held by his order dated 30.1.2004 that the mark is not registerable in view of the objections of the Tindivanam Party under Sections 11 and 12(2) of the Act. However, the Assistant Registrar held that the Kanagayam Party was using the mark independently and sufficiently and that therefore it could be registered under Section 12 of the Act, subject to certain conditions. On an appeal against this order in O.A.No.26 of 2004, the Appellate Board that the Assistant Registrar ought not to have permitted even conditional registration for the Kangayam Party and consequently directed the Assistant Registrar to dismiss the application for registration filed by the Kangayam Party.

(J) Though the Kangayam Party filed a review petition against the said order of the Appellate Board, the Kangayam Party admitted in Ground No.ZB of the additional grounds raised in their petitions for review that in view of the prior registration in favour of the Delhi Party, the applications for registration filed by both the Kangayam as well as Tindivanam Party were liable to be rejected. Thus the original claim of the Kangayam Party to be "a honest concurrent user" was actually given up by them during the review petitions. Therefore, the Kangayam Party is deemed to have waived their rights to claim honest concurrent user and consequently they will have to stand or fall only on the strength of the assignment from the Delhi Party.

(K) In view of the fact that the Kangayam Party has virtually given up their claim for registration as an honest concurrent user, the orders passed in the appeals O.A.No. 24 and 25 of 2004 by the Appellate Board cannot be said to be illegal. Consequently, the orders passed in the review petitions R.P.Nos. 2 and 3 of 2004 arising out these orders in O.A.Nos.24 and 25 of 2004 cannot alsobe found fault with. Therefore the civil revision petitions C.R.P.Nos.808 and 809 of 2006 arising out the dismissal of the Review petitions R.P.Nos. 2 and 3 of 2004 are dismissed.

(L) But in so far as the order passed in R.P.No.4 of 2004 arising out of O.A.No.26 of 2004 is concerned, there is a little difference. As seen from the narration of facts, the said appeal O.A.No.26 of 2004 was filed by the Kangayam Party against the order of the Assistant Registrar dated 23-1-2004 granting registration to the Tindivanam Party (in the names of B.MOHAMMED YOUSUF, B.MOHAMMED SHERIFF AND B.HYDER ALI, trading as MUJEEB MODERN RICE MILL as per their application dated 4-8-1992). Instead of simply dismissing or allowing the appeal, the Appellate Board went one step ahead and granted a relief to the Tindivanam Party by directing the Registrar to permit amendment of their application for registration by

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

confining the registration to B.Mohammed Yousuf alone. Let us test the validity of the said order while dealing with the rights of the Tindivanam Party in the next chapter of this order. In so far as the claim of the Kangayam Party for registration is concerned, on their own admission in Ground No.ZB in their additional grounds for review, their application was liable to be rejected and hence we dismiss C.R.P.Nos.808 and 809 of 2006.

(M) In addition to assailing the claim of the Kangayam Party on other grounds, Mr.P.S.Raman, learned Additional Advocate General appearing for the Tindivanam Party also contended that the Kangayam Party was guilty of committing a fraud upon the Appellate Board, by producing certain bills of its customers. Originally, the Kangayam Party has taken a stand before the Registrar that the old records were destroyed for want of place and copies of the invoices from the year 1990 alone were available. Subsequently, the Kangayam Party filed additional evidence in the form of certain bills of the year 1980 to 1982 containing the Pincode of location of its customer at Tiruppur as 641 605. The bills so produced were of the year 1980 to 1982 and all of them contained the Pincode of Sri Sakthi Ganesh Textiles as 641 605. But as per the Postal Index Number Code of delivery Post Offices Tamil Nadu Circle issued by the Chief Post Master General Tamil Nadu, the Pincode of Tiruppur was actually 638 601 at that time and it was changed to 641 601 and so on, only after the year 2002. Therefore, according to the learned Additional Advocate General, the Kangayam Party wanted to perpetrate a fraud upon the Registrar as well as the Appellate Board in judicial proceedings and that therefore, they were not entitled to any relief. In this connection, the learned Additional Advocate General relied upon the judgments of the Supreme Court in S.P.Chengalvaraya Naidu (Dead) by LRs vs. Jegannath (Dead) by LRs (AIR 1994 SC 853), S.J.S. Business Enterprises Pvt. Ltd vs. State of Bihar and Others (2004 7 SCC 166), and Bhaurao Dasdu Paralkar vs. State of Maharashtra and Others (AIR 2005 SC 3330).

(N) It is true that the Courts of law are meant for imparting justice between the parties and a person whose case is based on falsehood has to be summarily thrown out at any stage of the litigation. But we do not propose to go into the said question, since we have upheld the orders of the Appellate Board passed in R.P.Nos.2 and 3 of 2004 and dismissed the CRP (NPD) Nos.808 and 809 of 2006 arising out of the same.

35. RIGHTS OF THE TINDIVANAM PARTY:-

(A) As seen earlier, the application for registration of a trade mark was made by the Tindivanam Party in the names of three brothers by name B.MOHAMMED YOUSUF, B.MOHAMMED SHERIFF AND B.HYDER ALI, claiming to be trading as "MUJEEB MODERN RICE MILL" on 4-8-1992.

(B) However, in support of their application for registration, Mr.B.Mohammed Yousuf filed evidence in the form of an affidavit. In para 1 of the said affidavit filed on 20.1.1999, the said B.Mohammed Yousuf described himself as the sole Proprietor of Mujeeb Modern Rice Mill. In para-2 of the affidavit, he claimed that he was carrying on business in

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

partnership with five other persons, under the name "B.BASHEER AHAMED & BROTHERS" and that the partnership firm owned "MUJEEB MODERN RICE MILL". In para-3 of the affidavit, he claimed that the partnership firm B.Basheer Ahamed and Brothers adapted the brand name "Maharaja" in the year 1983 to market the rice produced in its rice Mill, Mujeeb Modern Rice Mill. In para-4 of the affidavit, the deponent Mr.B.Mohammed Yousuf claimed that the firm B.Basheer Ahamed and Brothers was dissolved on 30.3.1988 and that he got an absolute right along with his two brothers B.Mohammed Sheriff and B.Hyder Ali over the property viz., "Mujeeb Modern Rice Mill and other machineries installed therein". In para-5 of the affidavit, he also contended that by an agreement dated 30.3.1988, he got the consent of all the other five partners and got the full right and absolute ownership of the brand.

(C) Thus, through the affidavit filed as and by way of evidence before the Registrar of Trade Marks in support of their application for registration, Mr.B.Mohammed Yousuf claimed to be the Proprietor of the Trade Mark. But the application for registration was made by him on 4.8.1992 in the names of himself and his two brothers. As a matter of fact, based upon the said application dated 4.8.1992, the Tindivanam Party was also issued with a certificate of registration dated 26.2.2004, after the Assistant Registrar of Trade Marks passed an order in favour of the Tindivanam Party on 23.1.2004. It is pertinent to point out that the application of the Tindivanam Party for registration, was allowed conditionally by the Assistant Registrar of Trade Marks by his order dated 23.1.2004, whose operative portion reads as follows:-

> "Hence the registration of applicant always shall be used with full name and address of the applicant's firm in prominent feature on the label, sticker etc under Section 12 of the Act."

(D) Thus, it is clear that the application for registration was made by Tindivanam Party on 4.8.1992 in the names of three brothers trading in the name of "Mujeeb Modern Rice Mill" and their application itself was treated by the Assistant Registrar as an application by a firm. Consequently, the order of the Assistant Registrar dated 23.1.2004 also directed the Tindivanam Party to use the trade mark always along with the full name and address of the applicant's firm. The affidavit of evidence filed by Mr.B.Mohammed Yousuf claiming to be the Proprietor of the trade mark by virtue of an agreement dated 30.3.1988 and by virtue of the dissolution of the partnership, was omitted to be taken note of by the Assistant Registrar. If the Registrar had taken note of the evidence let in by Tindivanam Party, he could not have granted registration to the Tindivanam Party, on account of the simple fact that the application was by 3 persons claiming joint ownership of the trade mark, but evidence related to the claim of a single person claiming to be a proprietor. In other words, the applicants (3 in number) failed to produce any evidence of user in support of their application for registration, but got a certificate of registration issued in their joint names.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

(E) Though the omission on the part of the Assistant Registrar to note the contradiction in terms, on the part of Tindivanam Party (in filing the application jointly in the names of 3 persons, filing the affidavit of evidence by a single person claiming as Proprietor and getting an order jointly in the names of 3 persons constituting the partnership firm) was brought it to the attention of the Intellectual Property Appellate Board, by the Kangayam Party, in its appeals the Intellectual Property Appellate Board rejected the said contention on the basis of the affidavits filed by the brothers of Mr.B.Mohammed Yousuf to the effect that they do not claim any right in respect of the disputed trade mark and that they have no objection to register the name of the first respondent alone. If the Appellate Board had merely stopped with the said finding, the Tindivanam Party would have been made to file appropriate application for amendment or variation before the Registrar. But by its order dated 6.8.2004, passed in O.A.No.26 of 2004, in the appeal filed by Kangayam Party, the Appellate Board not merely dismissed the Kangayam Party's appeal but went to the extent of granting a relief to the Tindivanam Party. In para-20 of its order, the Appellate Board, issued a direction to the Registrar to amend the application for registration filed by Tindivanam Party by deleting the names of the brothers of B.Mohammed Yousuf and confining the application for registration to B.Mohammed Yousuf alone.

(F) Therefore the order passed by the Appellate Board in O.A.No.26 of 2004 and confirmed in R.P.No.4 of 2004, to the extent that it issued a direction in favour of the Tindivanam Party, on an appeal filed by the Kangayam Party, is clearly erroneous for the following reasons:-

1) On an appeal filed by Kangayam Party, the Appellate Board ought not to have granted a relief to the Tindivanam Party. This is especially so since the very basis of the appeal of the Kangayam Party was that the Assistant Registrar cannot grant registration to 3 persons in their joint names when they let in evidence in favour of a single proprietor. The Appellate Board overruled the said objection and yet issued a direction to the Registrar to remedy the situation.

2) Apart from the fact that the Tindivanam Party was not entitled to a relief on an appeal by the Kangayam Party, the relief granted by the Board to the Tindivanam Party was beyond the scope of the appeal. The question that arose for consideration in the appeal was as to whether the order of the Registrar permitting registration of the mark of the Tindivanam Party was right or not. After holding the order of the Assistant Registrar to be valid, the Appellate Board cannot issue a direction to the Registrar to amend the very application of the Tindivanam Party.

3) Moreover, the order of the Assistant Registrar

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

allowing the application of Tindivanam Party (in the name of a partnership firm) was passed on 23.1.2004. In pursuance of the said order, a certificate of registration was issued in the name of the Tindivanam Party (in the joint names of 3 persons, as per their original application) by the Registrar on 26.2.2004. Therefore, on 6.8.2004, when the Appellate Board passed an order in O.A.No.26 of 2004, giving the direction for amendment of the application of the Tindivanam Party, the application of the Tindivanam Party for registration was not even pending. The application for registration had been disposed of on 23.1.2004 and a certificate of registration had already been issued on 26.2.2004. But the Appellate Board issued direction to the Registrar in O.A.No.26 of 2004 to amend the application for registration of the Tindivanam Party by deleting the names of the brothers of Mr.B.Mohammed Yousuf.

4) The Trade Marks Act,1999 and the Trade Marks Rules,2002 prescribe separate procedures for amendment of an application for registration as well as an amendment of the very certificate of registration. While section 22 provides for amendment of an application for registration for the correction of any error, section 23(4) provides for amendment of the Register and the Certificate of registration only for the purpose of "correcting a clerical error or an obvious mistake". In contra distinction, section 58 empowers the Registrar to correct any error or enter any change in the name and address or the description of the registered proprietor, on an application made by him. Overlooking these provisions, the Appellate Board in its order dated 6-8-2004 passed in O.A.No.26 of 2004 directed the Registrar to amend the application of the Tindivanam Party, after the issue of the certificate of registration itself. Therefore, that portion of the order of the Appellate Board in O.A.No.26 of 2004 dated 6.8.2004 granting a relief to the Tindivanam Party is not in accordance with law. Though this aspect was canvassed by the Kangayam Party in it review petition R.P.No.4 of 2004, the Appellate Board confined itself only to the question of assignment while dealing with the review. Therefore the offending portion of the order of the Appellate Board in its order dated 6-8-2004 passed in O.A.No.26 of 2004 as confirmed by the order dated 15-3-2006 in R.P.No.4 of 2004 is liable to be set aside. Accordingly C.R.P.No. 810 of 2006 arising out of R.P.No.4 of 2004 of the Appellate Board shall

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

stand allowed to the extent that the direction contained in the order dated 6-8-2004 passed in O.A.No.26 of 2004 to the Registrar to amend the application of the Tindivanam Party shall stand set aside.

(G) Once the direction of the Appellate Board for amendment of the application for registration of the Tindivanam party goes, then their application for renewal in the name of the single person, which is the subject matter of the writ petition W.P.No.28352 of 2004, should also go. However, even without reference to our decision regarding the original registration, the Tindivanam Party is not entitled to renewal for the reasons found in the following paragraphs.

(H) Under Section 25(1) of the Trade Marks Act, 1999, a certificate of registration issued by the Registry is valid only for a period of ten years from the date of registration. The date of registration, under the Trade Marks Act, is specifically taken to be the date of registration indicated in the certificate of registration. To enable persons to whom a certificate of registration is issued only after the expiry of ten years from the date of the original application, Rule 64 (3) provides a further period of six months from the date of issue of the certificate of registration. In this case, the certificate of registration was issued on 26.2.2004 and admittedly, the application for renewal in Form TM-12 was filed on 16.9.2004. Therefore, according to the Delhi Party, the application for renewal filed beyond the period of six months from 26.2.2004 (the date of issue of the certificate of registration) was to be rejected. It is only on this basis that W.P.No.28352 of 2004 has been filed by the Delhi Party for preventing the renewal of registration in favour of Tindivanam Party.

(I) As seen from the sequence of events narrated above, the crucial dates to be taken into account for deciding this issue, are as follows:-

4.8.1992 - application filed by B.Mohammed Yousuf and two others as partners of Mujeeb Modern Rice Mill.

23.1.2004 - order of the Assistant Registrar allowing the application for registration subject to the condition that the name of the firm and address shall be printed on the label prominently.

26.2.2004 - certificate of registration issued by the Assistant Registrar as per the original application in the joint names of all the 3 persons.

-- No application for amendment or variation filed by Tindivanam Party under section 58.

6.8.2004 - on the appeal filed by Kangayam Party, Appellate Board passes an order directing the Registrar to amend the application for registration suo moto, and

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

confine the registration to B.Mohammed Yousuf alone, even while dismissing the appeal of Kangayam Party.

2.9.2004 -- Tindivanam Party files Form TM-33 for amendment in pursuance of the order of the Appellate Board

3.9.2004 – The certificate of registration is amended by the Registrar of Trade Marks by merely erasing the names of the other two partners in the original certificate of registration dated 26.2.2004.

16.9.2004 – application for renewal in Form TM-12 filed by Tindivanam Party.

(J) Mr.P.S.Raman, learned Additional Advocate General contended that though the original certificate of registration was issued on 26.2.2004, it was the subject matter of appeal before the Appellate Board, which ultimately dismissed the appeal on 6.8.2004 and also directed the amendment of the application for registration. Such amendment was carried out on 3.9.2004 by the Registrar of Trade Marks and on 16.9.2004 (within 13 days of the amendment) the application for renewal was filed. In this connection, Mr.P.S.Raman, learned Additional Advocate General invited our attention to Rule 64 (3) of the Trade Marks Rules, 2002 which reads as follows:-

> "Rule 64(3) Where, in the case of a mark the registration of which (by reference to he date of application for registration) becomes due for renewal, the mark is registered after the date of renewal, the registration may be renewed by the payment of the renewal fee within six months of the actual date of registration and where the renewal fee is not paid within that period the Registrar shall, subject to rule 66, remove the mark from the Register."

Therefore, according to him, even if the date of the order of the Appellate Board namely 6-8-2004 is taken into account, the application for renewal was filed on 13.9.2004 within six months.

(K) De hors the above contention the learned Additional Advocate General also brought to our attention, the provisions of Section 25(3) of the Trade Marks Act, 1999, which reads as follows:-

> "Section 25. Duration, renewal, removal and restoration -
>
> (3) At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the Register:

Provided that the Registrar shall not remove the trade mark from the Register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the trade mark and shall renew the registration of the trade mark for a period of ten years under sub-section (2)."

On the basis of the said provision, he contended that the Registrar of Trade Marks has not sent any notice before the expiry of the period of registration as required under Section 25(3) and that therefore, the registration of Tindivanam Party cannot be removed.

(L) In short, the contention of the learned counsel for the Tindivanam Party is that the original certificate of registration dated 26.2.2004 merged in the order of the Appellate Board dated 6.8.2004 and the amendment carried out on 3.9.2004 and that therefore the period of limitation should be taken to run only from the said date and not from the original date of registration viz., 26.2.2004. In order to drive home this point, the learned Additional Advocate General relied upon the judgment of the Supreme Court in Union of India and Others vs. West Coast Paper Mills Ltd and Another {(2004) 3 CTC 53}, wherein it was held the doctrine of merger applied to courts and tribunals.

(M) But we are of the considered view that the doctrine of merger does not apply to the case on hand. As we have observed above, the Tindivanam Party was granted a relief by the Appellate Board, in an appeal filed by Kangayam Party and that too which fell beyond the scope of the appeal. The order of the Appellate Board dated 6.8.2004 did not direct the Registrar to amend the certificate of registration. It directed the Registrar to amend the application for registration of the Tindivanam Party, when the application was no more pending. Therefore, the direction issued by the Appellate Board could not have been complied with by the Registrar. This is why, the Tindivanam Party had to file Form TM-33 under section 58 on 2-9-2004 for entering a change in the description of the registered proprietor. If the doctrine of merger was to apply, the Tindivanam Party need not have done anything except to rely upon the order of the Board to effect a change in the description. Therefore, we do not accept the contention regarding merger. In any event, we have set aside the order of the Appellate Board in this regard and hence there is no merger.

(N) In so far as the Trade Marks Act, 1999 is concerned, the period of limitation for seeking renewal starts from the date of registration, since Section 25(1) prescribes a period of validity of ten years for a registered trade mark and sub section (2) of Section 25 uses

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

the words "from the date of expiration of the Original Registration". This is why Rule 63(1) requires an application for renewal to be made within six months before the expiration of the last registration. Rule 64 (3) extracted above provides for a contingency where the registration itself is done after it had become due for renewal with reference to the date of application for registration. Therefore, apart from being extraneous to the scope of the appeal, the order of the Appellate Board virtually did not alter the date of registration. The words "within six months of the actual date of registration" used in Rule 64(3) has a lot of significance. As seen from the various provisions of the Act, the certificate of registration may undergo a lot of changes, due to assignment, amendment, variation etc. Therefore, if the contention of the learned Additional Advocate General is to be accepted, then the actual date of registration would get merged or extended by every act of a party such as assignment, amendment or variation. Therefore, the question of merger does not arise.

(O) The provisions of Section 25(3) also do not go to the rescue of the Tindivanam Party since they deal with the procedure to be adopted for removing the trade mark from the Register upon failure of a party to renew the registration. As and when, the Registrar takes steps to remove the trade mark from the Register, under Section 25, the Tindivanam Party can always claim the benefit of the statutory notice prescribed under sub Section (3). Therefore, in our considered opinion, the application for renewal made by Tindivanam Party on 16.9.2004 was beyond the period of limitation prescribed under the Act and hence W.P.No.28352 of 2004 filed by the Delhi Party for preventing the Registrar from renewing the registration of the Tindivanam Party deserves to be allowed. Consequently, the Writ appeal W.A.No.863 of 2006 arising out of the interim injunction granted in WPMP No.34413 of 2004 in W.P.No.25382 of 2004 is liable to be dismissed.

In the result, we allow W.P.No.28352 of 2004 and dismiss W.A.No.863 of 2006.

36. RIGHTS OF THE DELHI PARTY:-

(A) The registration of the word mark "MAHARAJA SPECIAL" in favour of the Delhi Party is dated 23.5.1977 and the registration has been granted on the basis of their claim that they have a long usage of the trade mark since 1966. The Tindivanam Party and Kangayam Party jumped into the fray in the year 1992 claiming user since 1983 and 1980 respectively. The following table would give comparative statement of the claims of the parties involved in this dispute:-

Party	Date of Registration	User claimed since
Delhi	23-05-1977	1966
Tindivanam	26-02-2004	1983
Kangayam		1980

WEB COPY
https://hcservices.ecourts.gov.in/hcservices/

(B) The Kangayam Party has entered into a deed of assignment with the Delhi Party on 5.10.2004, virtually conceding the ownership rights of the Delhi Party. In paragraph-5 of the deed of assignment, the Kangayam Party has made an admission to the following effect:-

> "The assignee now recognizes that the assignor is the sole and exclusive proprietor of the registered mark MAHARAJA registered under No.325536 in Clause 30 for rice and owns the logo of MAHARAJA under common law by use."

Thus the Kangayam Party has no quarrel with the Delhi Party.

(C) In so far as the Tindivanam Party is concerned, their fight was originally only with the Kangayam Party. But the institution of C.S.No.726 of 2004 by the Delhi Party, the filing of W.P.No.28352 of 2004 by the Delhi Party against the renewal of registration in favour of Tindivanam Party, the filing of a criminal complaint in C.C.No.26937 of 2004 by the Delhi Party against the Tindivanam Party and the assignment entered into between the Delhi Party and Kangayam Party on 5.10.2004, triggered a serious reaction by the Tindivanam Party filing two applications, against the Delhi Party one for rectification of Register in ORA No.1 of 2005 on the file of the Appellate Board and the other for prosecution under Section 107 of the Trade Marks Act, 1999 on the file of the Registrar. The Tindivanam Party was partly successful in their application for rectification, since the Appellate Board allowed ORA No.1 of 2005 partly on 15.3.2006, directing the Registrar to restrict the area of operation of the Delhi Party within the territorial of Delhi only. This order of the Appellate Board passed in ORA No.1 of 2005 has given rise to two sets of proceedings, one by the Delhi Party filing CRP No.800 of 2006 and the other by the Tindivanam Party filing W.P.No.25372 of 2006. Therefore, if the order of the Appellate Board in ORA No.1 of 2005 is tested, the rights of the Delhi Party vis-à-vis Tindivanam Party could be determined.

(D) The Tindivanam Party sought rectification of the Register by removing the trade mark of the Delhi Party from the Register, on two grounds viz., (i) that the Delhi Party in whose favour the trade mark was registered, was a partnership firm by name M/s.Prabha Singh Jaswant Singh, comprising of three partners by name S.Prabha Singh Malhotra, Jaswant Singh Malhotra and Johinder Singh Malhotra and that two out of those three partners already died and the Delhi Party failed to effect any change in the partnership resulting in the Delhi Party loosing the proprietorship of the trade mark, and (ii) that at any rate the Delhi Party did not use the trade mark for the statutory period as contemplated under Section 47(1)(a) and (b) of the Act.

(E) In answer to the aforesaid two grounds raised by the Tindivanam Party, for cancellation of the registration of the Delhi Party, the Delhi Party contended that one of the partners of the firm died in the

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

year 1987 after which his wife and two sons were taken as partners. Subsequently, the wife and one of the sons died and thereafter the sons of the remaining partner were also inducted. Thus, according to the Delhi Party, the legal heirs of the deceased partners were inducted on the death of the original partners and that therefore the first ground on which the Tindivanam Party sought rectification, has to fail.

(F) In so far as the issue of non-user of the trade mark for the statutory period as contemplated under Section 47(1)(a) and (b) of the Act is concerned, the Delhi Party has contended before the Appellate Board that they have been using the mark with the knowledge of the Tindivanam Party on the date of filing the rectification application and that even the assignment deed dated 5.10.2004 confirmed their user.

(G) The Appellate Board by its order dated 15.3.2006 passed in the rectification application ORA No.1 of 2005, held that the deed of assignment made by the Delhi Party in favour of Kangayam Party was invalid. As a consequence of such a finding, the Appellate Board held that the Delhi Party had not established continuous user as required under Section 47 of the Act, at least in so far as the State of Tamil Nadu is concerned. Therefore, the Appellate Board issued a direction for rectification of the Register, directing the Registrar to amend the Certification of Registration by restricting the area of operation of the Delhi Party to Delhi only.

(H) In view of the conflicting positions taken by the Delhi Party and Tindivanam Party, two questions arise for consideration. They are:-

a) Whether the death of two out of three partners of the firm described as Delhi Party, resulted in the loss of proprietorship of the trade mark of the firm?

b) Whether the deed of assignment dated 5.10.2004 was legally valid?

(I) Before venturing to deal with the aforesaid two questions, we will have to deal with a preliminary objection raised by the Delhi Party as to the very maintainability of the rectification application of the Tindivanam Party. According to Mr.S.J.Jagadev, learned counsel appearing for the Delhi Party, Section 124 of the Trade Marks Act, 1999 mandates the leave of the Court to be obtained before filing the rectification application, in cases where a civil suit for infringement is pending.

(J) Section 50 of the Trade Marks Act, 1999 confers powers upon the Registrar for variation or cancellation of registration of a registered user. Section 57 confers concurrent jurisdiction upon the Registrar and the Intellectual Property Appellate Board for canceling or varying the registration of a trade mark on the ground of any contravention or failure to observe a condition entered on the Register in relation thereto. But Section 125 empowers the Appellate Board alone to entertain the application for rectification in two types of cases viz., (i) where a suit for infringement of a registered trade mark is already

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

pending and the validity of the registration of the plaintiff's mark is questioned by the defendant in such proceedings and (ii) cases where a suit for infringement of a registered trade mark is pending and the defendant claims protection of registration of his own mark under the Act, but the plaintiff questions the validity of such registration of the defendant's mark. Thus, Section 125 conferring exclusive jurisdiction upon the Appellate Board is an exception to Section 57 conferring concurrent jurisdiction on both the Registrar and the Appellate Board.

(K) Section 124 deals with the procedure to be adopted by the Court trying a suit for infringement, where the validity of registration of the mark of the plaintiff or the defendant comes into question. Section 124 reads as follows:-

> "124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.
>
> (1) Where in any suit for infringement of a trade mark. ---
>
> (a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or
>
> (b) the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark,
>
> the court trying the suit (hereinafter referred to as the court), shall, ---
>
> (a) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the Appellate Board, stay the suit pending the final disposal of such proceedings;
>
> (b) If no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the register.
>
> (2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit."

(L) Mr.S.J.Jagadev, learned counsel appearing for the Delhi Party invited our attention to a judgment of the Division Bench of Gujarat High Court in Patel Field Marshal Agencies and Another vs. P.M.Diesels Ltd and Others (IPLR 1999 APRIL 1425) as well as the decision of a single Judge of the Delhi High Court in Astrazeneca UK Ltd and Another vs. Orchid Chemicals and Pharmaceuticals Ltd ((2006 (32) PTC 733 (Del.)). While the decision of the Division Bench of the Gujarat High Court arose under Section 111 of the old Act (Act 43 of 1958), the case before the Delhi High Court arose under Section 124 of the new Act (Act 47 of 1999) and both these provisions are actually inpari materia except that the words High Court appearing under Section 111 of the old Act have been substituted by the words Appellate Board under Section 124 of the new Act. The judgment of the Delhi High Court actually followed the judgment of the Division Bench of the Gujarat High Court. The Gujarat High Court held in para-10 of its judgment that if proceedings for rectification are not already pending, and a plea regarding invalidity of registration of the concerned mark is raised, the Court trying the suit has to be prima facie satisfied about the tenability of the issue and if it is so satisfied, it shall frame an issue to that effect and adjourn the case for three months, in order to enable the party concerned to apply for rectification. Particularly, the Division Bench of the Gujarat High Court held as follows:-

"In case, no such proceedings for rectification are pending at the time of raising the plea of invalidity, the prosecution of such plea by the person raising it depends on prima facie satisfaction of the Court, about the

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

tenability of this plea. If the plea has been found to be prima facie tenable and an issue is raised to that effect then the matter is to be adjourned for three months at least to enable the person raising such plea to approach the High Court concerned, with a rectification application. In case, the rectification proceedings are not already pending, and the Court is not even prima facie satisfied about the tenability of the plea raised before it, the matter rests there."

In paragraphs 30 and 31 of its judgment, the Delhi High Court held as follows:-

> "30. Under Section 124 (b) if the application for rectification is already pending the suit can be stayed pending final disposal of such proceedings. In case the application for rectification or any such proceedings is not pending, then a party seeking rectification can apply for rectification subject to prima facie satisfaction of the Court regarding invalidity of the registration of the mark of the opposite party. In the present case, the plaintiffs, however, have sought rectification of the trade mark of the defendant by filing an application first to the Registrar and thereafter to the Appellate Board without seeking prima facie satisfaction of this Court.
>
> 31. On plain reading of this provision, it is apparent that the plaintiffs could not file the application for rectification without showing and obtaining a prima facie satisfaction of the Court about their plea of the invalidity of the registration of the mark of the defendant."

(M) However, Mr.P.S.Raman, learned Additional Advocate General relied upon a decision of another single Judge of the Delhi High Court in M/s.Elofix Industries (India) vs. Steel Bird Industries and Others (AIR 1985 Delhi 258) to the effect that "Where after the service of summons in a suit seeking decree of perpetual injunction restraining the defendants from issuing a particular trade mark as it was infringement of plaintiff's trade mark, the defendants filed their written statement and simultaneously filed a petition under Ss.107, 46 and 56 of the Act for rectification of plaintiff's trade mark instead of requiring the Court to raise an issue regarding invalidity of plaintiff's trade mark, it is a substantial compliance with the provisions of S. 111(1)(B)(ii)".

(N) In our considered view, Section 124 (1)(b)(ii) of the Act is only an enabling provision. Sub clause (i) and sub clause (ii) of Clause (b) of sub section (1) of Section 124 operates at two different levels for two different situations. While sub clause (i) deals with a situation where any proceeding for rectification is already pending, sub clause (ii) deals with a situation where any proceeding for rectification is not

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

pending. Both the sub clauses focus their field of operation only in relation to the stay of the civil suit. The conditions laid down in sub clause (ii) are intended to enable a party to obtain stay of the suit and not intended to provide for a discretion for the Court to permit or not to permit any application for rectification. Such a position is made clear by sub sections (2) to (5) of Section 124, which deals with the consequences of filing and not filing an application for rectification and of the ultimate outcome of such application for rectification. In other words, the requirements of "raising an issue", "adjourning the case" and a "prima facie satisfaction" spelt out in Section 124 (1)(b)(ii) should be read as the requirements for the grant of a stay of the suit and not as a requirement or pre-condition for filing an application for rectification. The plain reading of Section 124(1)(b)(ii) shows that it does not mandate a party to obtain the "leave of the Court" or "an order of the Court", for filing an application for rectification. The right to file an application for rectification is a statutory right conferred upon a party who is aggrieved by an entry made in the Register. The said statutory right cannot be curtailed except by the very provisions of the statute. The said right is circumscribed by certain requirements such as the contravention of the provisions of the Act or failure to observe a condition entered on the Register etc., as spelt out under sub sections (1) and (2) of Section 57 of the Act. In respect of the "Forum" in which such an application for rectification could be filed, there is a restriction under Section 125, in that such an application could be filed only before the Appellate Board if a suit for infringement was already pending. Apart from these restrictions, we do not see any other restriction with regard to the filing of an application for rectification. To interpret Section 124 (1)(b)(ii) to mean that an order should be obtained from the civil Court for filing an application for rectification, regarding prima facie satisfaction, would amount to imposing one more restriction upon the right of a person to seek rectification of the Register. We do not find any such restriction or requirement of the leave/permission of the court, under section 124 (1) (b) (ii). Therefore, with great respect to the learned Judges who were parties to the decisions of the Gujarat and Delhi High Courts, relied upon by the Delhi Party, we are of the considered view that the Tindivanam Party was right in filing an application for rectification, without obtaining the leave of this Court or without getting an issue framed and prima facie satisfaction recorded, in C.S.No.726 of 2004.

(O) Coming to the grounds on which the Tindivanam Party sought rectification of the Register for removing the trade mark of the Delhi Party, it is seen that they are two fold. The first ground is with respect to the change in the Constitution of the firm (of the Delhi Party) and the effect of the same on the assignment in favour of Kangayam Party. The second ground is with respect to the non-user by the Delhi Party.

(P) In so far as the first ground is concerned, the Appellate Board did not go into the question of devolution of the rights of partners upon their legal representatives after their demise. In para-7 of its order dated 15.3.2006 in ORA No.1 of 2005, the Appellate Board merely

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

observed that there is nothing on record to show that the reconstitution of the partnership firm (Delhi Party) was entered in the Register of Trade Marks or with the Registrar of Firms and held as follows:- "We do not want to go into this issue in detail for the simple reason that this trade mark is being challenged only to get over the assignment in favour of respondents 12 and 13 who got such an assignment after the disposal of the appeals by this Appellate Board finding that the applicant is entitled for registration of the mark Maharaja brand with the device. We confine with regard to the assignment alone."

(Q) However, we find from the pleadings of the parties that the original registration of the trade mark granted on 23.5.1977 in favour of Delhi Party stood in the name of S.Prabha Singh Malhotra, Jaswant Singh Malhotra and Jaginder Singh Malhotra, trading as Prabha Singh Jaswant Singh. The said registration had been renewed by the Delhi Party, on 23.5.1984, 23.5.1991, 23.5.1998 and 23.5.2005. The last renewal granted on 23.5.2005 has a validity period of ten years. Thus, the Delhi Party's registration is in force as on date.

(R) It is admitted that the original partners S.Prabha Singh Malhotra, Jaswant Singh Malhotra and Jaginder Singh Malhotra were father and two sons. In 1987, the father died, leaving his two sons who were already partners, apart from his wife. Therefore the sons made the mother, a partner and thus reconstituted the firm and the deed of partnership on reconstitution was also filed before the Appellate Board. In the year 1994, the mother Mrs.Prabha Singh Malhotra and one son Jaswant Singh Malhotra died. Therefore, the son of Jaswant Singh Malhotra was inducted into the firm as the legal heir of his deceased father. Thus it is clear that the Delhi Party consists of family members trading as a partnership firm and the firm had not only been reconstituted from time to time but also got renewal of registration of the trade mark from time to time.

(S) Keeping this in mind, if we go to the next aspect of the first ground of attack, we would find that admittedly there was a procedural lapse on the part of the Delhi Party in executing the deed of assignment in favour of Kangayam Party. The deed of assignment dated 5.10.2004 shows the name of the "Assignor" as "S.Prabha Singh Malhotra, Jaswant Singh Malhotra and Joginder Singh Malhotra, trading as Prabha Singh Jaswant Singh". This description of the name of the Assignor is clearly erroneous, since Prabha Singh Malhotra as well as Jaswant Singh Malhotra were actually dead and gone as early as in 1987 and 1994 respectively.

(T) But the question whether such a wrong description of the name of the Assignor in the deed of assignment would vitiate the assignment itself, is to be considered with respect to the provisions contained in Chapter V of the Trade Marks Act, keeping in mind the fact that the Assignor and the Assignee have no dispute. Section 38 of the Trade Marks Act, 1999 makes a registered trade mark both "assignable" and "transmissible". The Section begins with a "Non-abstante Clause". Therefore the provisions of any other law governing assignment, are

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

overridden by Section 38 of the Act. Section 42 of the Act imposes a condition upon the Assignee to apply to the Registrar for suitable directions, within six months (extendable by three more months) of the assignment, when an assignment is made otherwise than in connection with the goodwill of the business of the Assignor. Section 45 also requires an Assignee to apply to the Registrar for registration of his title in pursuance of such assignment. In this case, admittedly the Assignee has also filed Form TM-23 with the Registrar and the proviso to Section 45 (1) empowers the Registrar to refuse to register the assignment or transmission if the validity of an assignment or transmission is in dispute between the parties. As stated above, there is no dispute between the Assignor and the Assignee in this case. As a matter of fact, the Assignor has come up with the plea of assignment in his response to the application for rectification filed by the Tindivanam Party. Therefore, the fact that there was a mis-description of the name of the Assignor in the deed of assignment, will not give rise to a cause of action for the Tindivanam Party (a stranger to the assignment), to question the validity of the same. The mistake in the description of the party is a curable mistake and cannot be said to be fatal, at least to the case of the Assignor, namely the Delhi Party. In fact, it is the Delhi Party who is the Assignor, who has challenged the finding and order of the Appellate Board relating to the assignment and hence we hold that the Tindivanam Party is not entitled to take advantage of the wrong description of the name of the Assignor in the deed of assignment, for the purpose of contending that the name of the Assignor should be removed from the Register.

(U) The Delhi Party has contended that there was a communication gap between them and their counsel who prepared the deed of assignment for signature and the same led to the wrong description of the name of the Assignor. The said explanation appears to be plausible.

(V) Coming to the second ground on which the Tindivanam Party sought rectification of the Register, it is seen from para-8 of the order of the Appellate Board dated 15.3.2006 in ORA No.1 of 2005 that the Appellate Board had virtually shifted the burden upon the Delhi Party to show user for the prescribed period of time.

(W) The right of a person to seek removal of a registered mark from the Register on the ground of non-use, emanates from Section 47 of the Act. This Section permits the removal of a registered trade mark from the Register at the instance of a "person aggrieved" on any of the two grounds mentioned in Clause (a) or (b) of sub section (1). The condition laid down under Section 47(1)(a) is that the trade mark sought to be removed from the Register, must be one which was registered without any bona fide intention for using the same in relation to such goods or services and that there was in fact no bona fide use of the mark for the time being upto a date of three months before the date of the application. The condition laid down under Section 47(1)(b) is that the trade mark sought to be removed from the Register, must be one of which there was no

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

bona fide use for a continuous period of five years upto a date of three months before the date of the application.

(X) In this case, the requirements of Section 47(1)(a) or (b), are not even pleaded properly by Tindivanam Party in their application for rectification filed on 19.1.2005 before the Appellate Board. In ground No. (c) after paragraph 12 of their application for rectification filed before the Appellate Board in ORA No.1 of 2005, the Tindivanam Party merely made a passing reference to Section 47 of the Act by pleading that the Delhi Party was not doing business with the trade mark and using the same for illegal purpose and that the trade mark was not used for bona fide purpose and liable to be removed under Section 47. Again in ground No.(d), the Tindivanam Party referred to Section 47 of the Act, just for the purpose of drawing an inference that there was no bona fide use of the trade mark in view of the civil suit and writ petition filed by the Delhi Party. Apart from these vague pleadings, the Tindivanam Party failed to satisfy the requirements of Section 47(1)(a) or (b) even in their application for rectification. As stated above, to attract Section 47(1)(a), the registration of the mark itself should be shown to have been made without any bona fide intention of using the same and it must also be shown that there was, as a matter of fact, no bona fide use of the trade mark for a period of three months. A vague pleading that there was no bona fide use by the registered proprietor, would not satisfy the twin requirements of Section 47(1)(a). Similarly, to attract Section 47(1)(b), the applicant should satisfy the non-user for a continuous period of five years upto a date three months before the date of the application. There is no pleading by the Tindivanam Party even with reference to this requirement under Section 47(1)(b). Therefore, the second ground on which the Tindivanam Party sought rectification of Register for removing the trade mark of the Delhi Party, also fails.

(Y) It is a well established principle that no amount of evidence can be looked into, in the absence of a pleading. We find in this case that the pleading of Tindivanam Party with respect to non-user is very vague and does not satisfy the requirements of the Section. At any rate, the Appellate Board has in fact, recorded a finding in para-8 of its order dated 15.3.2006 in ORA No.1 of 2005 that there has been "some use" of the trade mark in relation to the goods for which it was registered, within Delhi. Moreover, the Appellate Board did not hold the Delhi Party guilty of lack of bona fide either in its registration or in its use of the mark. Thus, while the pleading of the Tindivanam Party is with respect to bona fide use, the finding of the Appellate Board is with respect to non-use and that too only beyond the territory of Delhi. Therefore the order passed by the Appellate Board in the rectification application of the Tindivanam Party in ORA No.1 of 2005 dated 15.3.2006, cannot be sustained and is liable to be set aside. Hence the civil revision petition filed by the Delhi party against the said order of the Appellate Board, C.R.P.No. 800 of 2006 is allowed and the writ petition filed by the Tindivanam Party against the same order, in W.P.No.25372 of 2006 is dismissed.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

37. CONCLUSION:-

In fine, C.R.P.Nos. 808 and 809 of 2006, W.P.No.25372 of 2006 and W.A.No.863 of 2006 are dismissed. C.R.P.Nos. 800 and 810 of 2006 and W.P.No.28352 of 2004 are allowed and we summarise the result of the orders, as follows, so that the picture that emerges is clear:-

(a) As a consequence of the C.R.P.No.800 of 2006 being allowed and W.P.No.25372 of 2006 being dismissed, resulting in the dismissal of the rectification application O.R.A.No.1 of 2005 filed by the Tindivanam Party, the Delhi Party's registration of the mark in the year 1977 and the renewals granted thereon from time to time, would remain unchanged.

(b) As a consequence of the dismissal of the 2 revision petitions C.R.P.Nos.808 and 809 of 2006 filed by the Kangayam Party against the rejection of their review petitions R.P.Nos.2 and 3 of 2004 by the Appellate Board, the Kangayam Party's claim for a right to use the trade mark as a concurrent user is rejected.

(c) As a consequence of the C.R.P.No.810 of 2006 and writ petition W.P.No.28352 of 2004 being allowed, (and the writ appeal getting dismissed) the amendment of the certificate of registration of the trade mark of the Tindivanam Party granted by the Registrar goes and the Tindivanam Party shall not be entitled to have renewal of the registration.

(d) As a consequence of our finding with respect to the assignment made by the Delhi Party in favour of the Kangayam Party, they shall be entitled to the benefit of the assignment so long as the Delhi Party does not dispute the validity of the same.

Sd/-
Asst. Registrar.

/true copy/

Sub Asst. Registrar.

Svn

To
1.The Registar of Trade Marks,
O/o.The Trade Marks Registry,
Mumbai Boudhik Sampanda Bhavan,
Near Antop Hill Post Office,
S M Road, Antop Hill,
Mumbai-400 037.

WEB COPY

https://hcservices.ecourts.gov.in/hcservices/

2.The Assistant Registrar of Trade
Marks, O/o.The Trade Marks Registry,
Chennai IPR Building, G.S.T.Road,
Guindy, Chennai-600 032.

3.The Controller General of Patents,
Designs and Trade Marks,
Government of India,
Boudhik Sampanda Bhavan,
Near Antop Hill Post Office,
S.M.Road, Antop Hill,
Mumbai-400 037.

4. The Registrar,
Intellectual Property Appellate Board,
Guna Complex, Annex 1, 2nd Floor,
443, Anna Salai, Teynampet,
Chennai 18.

5. The Registrar of Trade Marks,
O/o. The Trade Marks Registry,
Mumbai, Central building,
M.Karva Road, Mumbai 400 020.

6. The Assistant Registrar of Trade Mark,
O/o. The Trade Mark Registry,
Chennai Rajaji Bhavan,
D Wing, Besant Nagar,
Chennai 90.

7. The Controller General of Patents,
Designs and Trade Marks,
Government of India,
Central Building, M.Karve Raod,
Mumbai 400 020.
+ 2 CCs to Mr.C.Daniel, Advocate SR NO50586
+ 1 CC To Mr. S.J.Jagadev, Advocate SR NO.50481
+ 1 CC To Mr. P.Saravana Sowmiyan, Advocate SR NO.50815
+ 1 CC To Mr. P.Wilson, Advocate SR NO.51022

WEB COPY

W.A.No.863 of 2006
and W.P.No.25372 of
2006 andW.P.No.28352
of 2004 and
C.R.P.Nos.800, 808,
809 and 810 of 2006

vc(co)
rvl, Gp/1.11.

https://hcservices.ecourts.gov.in/hcservices/